

## REMARKS

The undersigned Applicants' representative thanks the Examiner for the courtesies extended in an interview at the USPTO on July 6, 2006. During that interview, the Applicants' representative explained how the claims distinguish over the art of record. The Examiner agreed to consider the reasoning presented in the interview and reproduced below.

In the outstanding Office Action<sup>[1]</sup> mailed January 17, 2006, the Examiner rejected claims 1-12, 14-30, 32-48 and 50-54 under 35 U.S.C. 102(e) as being anticipated by *Gershman et al.* (US Patent No. 6,401,085) (*Gershman*). Based on the reasoning presented below, Applicants respectfully traverse the rejections of claims under 35 U.S.C. §§ 102(e) and request allowance of claims 1-12, 14-30, 32-48 and 50-54.

In order to properly establish that *Gershman* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claims at issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 calls for a combination including, for example:

providing a solicitation to a set of users sharing pre-selected characteristics, [and] incorporating in the solicitation at least an offer code and a universal resource locator (URL) corresponding to a web site. (emphasis added)

While the cited prior art may, at various points, refer to concepts and terms arguably similar to those recited in the claims, such concepts and terms are not disclosed in the

---

<sup>[1]</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

same combination or relationship as specifically required by the pending claims. In rejecting claim 1, the Examiner cites a particular passage in *Gershman* (Col. 37, line 55 to Col. 38, line 50) and implies that an International Standards Book Number (ISBN) constitutes the claimed "offer code." However, even assuming that an ISBN could constitute an "offer code," with which Applicant's do not necessarily agree, claim 1 requires at least (1) that the "offer code" be provided in "a solicitation," (2) that the solicitation be directed to a "set of users," and (3) that the set of users share "pre-selected characteristics." The citation of the Examiner (*Gershman*, Col. 37, line 55 to Col. 38, line 50) discloses none of these elements related in the manner required by the claim.

Neither the portions of the prior art cited by the Examiner, nor any other portion, disclose each and every element of claim 1. Absent a teaching of at least a "solicitation", an "offer code," a "URL," and a "set of users sharing pre-selected characteristics," related in the manner specified by claim 1, the cited prior art cannot anticipate claim 1. Moreover, claims 12, 16, 19, 30, 34, 37, 48 and 52 include recitations similar to those of claim 1. Accordingly, the cited art also cannot anticipate independent claims 12, 16, 19, 30, 34, 37, 48 and 52 for at least the same reasons set forth above in connection with claim 1. Therefore, Applicant requests that the rejection of these claims be withdrawn and the claims allowed.

Claims 2-11, 14, 15, 17, 18, 20-29, 32, 33, 35, 36, 38-47, 50, 51, 53, and 54 depend from the independent claims cited above (i.e., 1, 12, 16, 19, 30, 34, 37, 48, and 52). As explained, *Gershman* does not support the rejection of claims 1, 12, 16, 19, 30, 34, 37, 48, and 52. Accordingly, the cited art also fails to support the rejection of dependent claims 2-11, 14, 15, 17, 18, 20-29, 32, 33, 35, 36, 38-47, 50, 51, 53, and 54

for at least the same reasons set forth above in connection with claim 1. Therefore, Applicant requests that the rejection of these claims be withdrawn and the claims allowed.

### Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

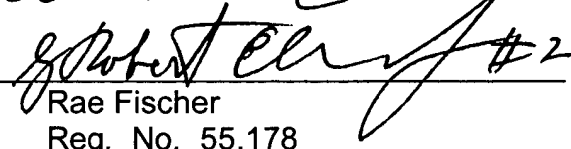
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 17, 2006

By:

  
Rae Fischer

Reg. No. 55,178

 #27,432